

## **REMARKS**

The Applicants have filed the present Amendment pursuant to 37 C.F.R. § 1.111 in reply to the outstanding Office Action of May 10, 2007, and Applicants believe the Amendment to be fully responsive to the Office Action for the reasons set forth below.

Claims 1, 3, 4, and 6-13 are currently pending. Claims 1, 3, 4 and 9-12 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,340,493 to Principato (hereinafter "Principato"). Claims 1, 3, 4, and 6-12 are rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 5,340,495 to Mulcahy (hereinafter "Mulcahy"). Claims 1 and 13 are rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by the combination of U.S. Patent No. 5,693,600 to Hendriksen (hereinafter "Hendriksen") in combination with Mulcahy or Principato.

According to the Examiner, Principato teaches a composition of esters, glycol ethers, and a surfactant as in Claim 1. Solvents as in Claim 9 of the present invention may also be present. Applicants respectfully traverse each of these rejections.

Turning to the anticipation rejection of Claims 1, 3, 4 and 6-13 over Principato, initially it is pointed out that Claim 1 of the present invention does not include a surfactant. The Examiner's attention is kindly directed to Example 3 of the present invention and the claims. The Principato cleaning composition is a three component composition as indicated at column 4, lines 18 under the section entitled "Detailed Description of the Invention", "The essential components of the inventive cleaning compositions comprise tall oil fatty acid esters, organic solvents such as aliphatic hydrocarbons, aromatic hydrocarbons, oxygenated solvents or terpene hydrocarbons, and mixtures thereof and surfactant." Moreover, Principato is limited to C<sub>18</sub> fatty acids or tall oil fatty acid esters, primarily C<sub>18</sub> oleic acid and linoleic acid, whereas the present invention is

directed to C<sub>4</sub> to C<sub>22</sub> fatty acids. Unlike Claim 1 of the present invention which is directed to a fatty acid ester blend and a lower alkyl glycol ether, Principato **requires** a surfactant and/or an organic solvent. At column 3, lines 63-68, Principato states, “For the purposes of this invention, tall oil fatty acid ester is essentially required to operate in combination with aliphatic hydrocarbons, aromatic hydrocarbons, oxygenated solvents, or terpene hydrocarbons, and mixtures thereof and surfactant in order to achieve the desired results.” Further, at column 4, lines 28-30, Principato states: “The tall fatty acid ester acts as the base of the ink cleaning composition of the present invention....However, used by itself, it is not an efficient or productive product for the application.” As such, this reference does not contain each and every element of the present invention, and thus, cannot anticipate same. Moreover, Principato does not contain each and every element of the present invention “arranged as in the claim” and again, cannot anticipate same.

The cleaning compositions of Principato possess properties completely different from those of the present invention. The compositions of the present invention, as indicated throughout the specification, are intended to coat the gas and oil wells to prevent adhesion and retard corrosion. Principato, on the other hand, specifically states that coating or an oily residue remaining on the roller and blanket surfaces is problematic and requires “constant rinsing with water....to remove the oily residue which remains on the roller and blanket surfaces. Also, if the emulsifier is not completely removed from the ink rollers, the ink will not adhere to the rollers and “stripping” will occur.” See column 2, lines 32-40.

Additionally, the use or specific application of the present invention differs from Principato. The compositions of Principato do not include the limitation of being applicable to injection into, and coating of, gas and oil wells and surrounding underground formations and

processing equipment for the purpose of removing scale, paraffins, tars and other viscous constituents. Where the specific application is different, there cannot be anticipation. *Union Oil Co. of California v. Atlantic Richfield Co*, 208 F.3d 989 (Fed. Cir. 2000), cert. denied, 531 U.S. 1183 (2001) (holding that composition claims that covered only standard unleaded automotive gasoline were not anticipated by aviation and racing fuels).

Therefore, Applicants submit that at least for the above mentioned reasons, the present invention cannot be anticipated by the Principato reference.

Turning to the 35 U.S.C. § 103(a) rejection of Claims 1, 3, 4 and 6-12 over the Mulcahy reference, according to the Examiner, Mulcahy teaches a cleaning composition of an ester and a glycol ether which can be a diethylene glycol ether of butanol, when ethylene oxide and a C<sub>4</sub> alcohol is used at a ratio of 2:1. The Examiner is correct that Mulcahy does not teach a specific use of the glycol ether but incorrectly concludes that this would be obvious.

Applicants respectfully disagree. The Examiner has not provided a convincing line of reasoning supporting a rejection under 35 U.S.C. § 103. The Examiner's statement that a specific use of the glycol ether would be obvious given the teaching of Mulcahy that such is useful in the cleaning composition is merely conclusory. Here, all claim limitations have not been accounted for.

Additionally, the present invention cannot be obvious over this reference inasmuch as Mulcahy is directed to nonanalogous art.

For Claims 1 and 13, the Examiner combines Mulcahy and Principato and concludes that the combination does not teach use of an antioxidant in the composition. The Examiner then relies on Hendriksen to teach use of antioxidants.

For the 35 U.S.C. § 103(a) rejection of Claims 1 and 13, over the combination of Mulchaly or Principato in view of Hendriksen, each of the references pertain to cleaning ink presses, and not preventing build-up of paraffin, tars, ink, etc as in the present invention.

Inasmuch as these references represent nonanalogous art, they cannot render the present invention obvious. However, in addition to the scope and content of these references, other factors as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 18 (1966), such as commercial success and fulfillment of a long felt but unmet need speak against obviousness. Four previous methods to clean the buildup of paraffin, sulfur, scale, heavy oil and tar-by products from oil wells and surrounding underground formations are described in the present specification in the "Background of the Invention" section at paragraphs [0003]-[0010]. None of these methods have been successful in solving the problem.

The present invention solves the problem and provides a high flash point, low vapor pressure composition with good soil and paraffin penetration, having excellent protection against resoiling and scale buildup capable of use in ambient and elevated temperatures which is safe and biodegradable.

Thus, Applicants respectfully submit that the rejections under 35 U.S.C. § 103 are obviated and withdrawal thereof is respectfully requested.

Accordingly, the present invention is believed to be in condition for allowance, which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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